

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Gokhale et al.

Application No.: 09/991,900

Confirmation No.: 3389

Filed: November 23, 2001

Art Unit: 2161

For: METHOD AND SYSTEM FOR
SCHEDULING MEDIA EXPORTS

Examiner: T. Y. Chen

REPLY BRIEF UNDER 37 C.F.R. § 41.41

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief responds to the Examiner's Answer.¹ In the Answer, the Examiner reiterates her conclusion that the claims are obvious. (Answer at p. 13.) However, as the following discussion shows, the Examiner's conclusion is premised upon inconsistencies and serious errors. Among them:

1. The Examiner supports her rejection of the claims in a manner inconsistent with her previous rejection.
2. The Examiner misinterprets the claim language.
3. The Examiner's understanding of an applied reference is incorrect.
4. The Examiner again fails to clearly articulate why the claims would have been obvious.

¹ Examiner's Answer mailed April 16, 2010 ("Answer").

A. The Examiner Supports Her Rejection of the Claims in a Manner Inconsistent With Her Previous Rejection

The first section of the Answer repeats the rejection of claims 1-20 under 35 U.S.C. § 103(a) over Crouse² and Sitka³ the Examiner made in the Final Office Action⁴. (See Answer at pp. 3-7.) In the second section, the Examiner responds to the applicants' arguments made in the Appeal Brief.⁵ (See Answer at pp. 7-13.) In responding, the Examiner states "Crouse clearly disclosed the claimed limitations recited as following" and then enumerates all of the features of claim 1, followed by citations to portions of Crouse that allegedly correspond to each feature. (Answer at pp. 8 and 9.) The Examiner then states "[i]n addition, Sitka also disclosed the claimed removable storage files import/export processes over a hierarchical/direct storage management system." (Answer at p. 9.)

The Examiner thus asserts that Crouse discloses all the features of claim 1, and therefore implies that Crouse can support a 35 U.S.C. § 102 rejection of claim 1. This is not only a shifting of the grounds previously used to reject claim 1 (*i.e.* Crouse and Sitka under 35 U.S.C. § 103(a)), but it is also inconsistent with the rejection of claim 1 the Examiner made 2 pages earlier. (See Answer at p. 7, stating "[a]s to claims 1-11 and 18-20, these claims recited similar features as cited in claims 12-17, in form of method or computer readable medium, hence are rejected for the same reason [as claim 12, which was rejected under 35 U.S.C. § 103(a)].")

In sum, the Examiner's response to the applicants' arguments is inconsistent not only with the Final Office Action, but also with the Answer itself. Accordingly, the Board should give no consideration to the Examiner's response to the applicants' arguments.

² U.S. Patent No. 5,764,972.

³ U.S. Patent No. 6,330,572.

⁴ Final Office Action mailed May 18, 2009 ("Final Office Action").

⁵ Applicants' Appeal Brief filed January 19, 2010.

B. The Examiner Misinterprets the Claim Language

Claim 12 is generally directed toward a system for scheduling an export of one or more removable media (e.g., magnetic tapes) from a storage device (e.g., a tape library). Claim 12 recites, *inter alia*, "a user interface for receiving, at a first time, export identification data comprising ... second data identifying a second time at which the identified one or more removable media is scheduled to be exported" and "a task control subsystem for retrieving the export identification data at the second time from the data file and controlling the storage device to cause the export of the removable media identified by the media identification data."

The Examiner misinterprets exporting as this term is used in claim 12. The Examiner appears to equate scheduling the export of removable media from a storage device with scheduling file input and output operations on removable media. In the Answer, the Examiner cites to portions of Crouse that allegedly relate to receiving media identification data in accordance with media migration scheduled attributes. (See Answer at p. 4.) The referred-to migration pertains to file migration across different data stores, and not to exporting removable media. (See Crouse at 15:19-30, describing automatic migration of files from on-line storage to archival media.) However, exporting, as this term is used in claim 12, cannot be construed as migrating files. Exporting involves, for example, removal of a physical removable storage medium from a storage library. In contrast, migrating files involves copying intangible data from one place to another.

The Examiner concedes that Crouse does not disclose scheduling an export of removable media. (See Answer at p. 5, stating "Crouse did not specifically disclose the file input/output commands including an exporting command."⁶) However, the Examiner states that "Sitka disclosed a data storage system to automatically scheduling an import

⁶ The Examiner previously conceded that Crouse does not disclose or suggest scheduling the export of removable media and exporting the removable media according to the schedule. (See the Final Office Action at p. 3, stating "Crouse did not specifically disclose the file input/output commands including a scheduling of an exporting processing.") It appears that the Examiner is again making this concession, although this is not entirely clear due to the Examiner's misinterpretation of the claim language.

and export I/O commands for removable devices." (Answer at p. 5.) This further reveals that the Examiner misinterprets the term exporting by equating scheduling an export of removable media from a storage device with scheduling commands for file import and export operations on removable media with.⁷

In sum, the Examiner misinterprets the language of the claims, and such misinterpretation is a clear error. Therefore, the Board should disregard the Examiner's interpretation of the claim language.

C. The Examiner's Understanding of Sitka is Incorrect

The Examiner states that Crouse and Sitka teach all the features of the claims. (See Answer at pp. 3-7, arguing that these references disclose all the features of claims 1-20.) As previously noted, the Examiner concedes that Crouse does not disclose scheduling an export of removable media. Also as previously noted, the Examiner relies on Sitka to cure Crouse's deficiencies and argues that Sitka describes scheduling an export of removable media.

This is an error. In the Appeal Brief, the applicants set forth in detail the reasons why Sitka does not teach or suggest scheduling the export of removable media and exporting the removable media according to the schedule. In brief, Sitka describes migrating files between data stores according to a schedule. (See Sitka at 17:44-53, describing a migration time window in which to carry out a migration of files.) However, scheduling a migration of files from one data store to another does not correspond to scheduling the export of removable media, for several reasons. A first reason is that a file is not a removable medium. The applicants' specification gives examples of removable media: magnetic tapes and optical disks. (See applicants' specification at paragraph [0024].) Sitka defines a file as "a user-defined blob of information that can be stored in DSM system 10." (Sitka at 8:38-39.) A removable medium such as a magnetic tape or optical disk is not user-defined; rather, it is a physical, tangible item. A

⁷ The Examiner similarly misinterprets the language of claim 1. (See Answer at p. 9, stating "In addition, Sitka also disclosed the claimed removable storage files import/export processes.")

user-defined blob of information is simply electronic data contained on a data storage device. No person of ordinary skill in the art would equate a user-defined blob of information with a removable medium. Because a file is not a removable medium, scheduling a migration of files does not correspond to scheduling the export of removable media.

Sitka also describes exporting a volume from a library upon reaching a library threshold storage capacity. (See Sitka at 26:24-27, stating "[w]hen the library capacity reaches some threshold, an agent will combine the oldest files on loaded volumes onto a single volume for export. That volume can then be exported and a fresh volume can be imported.") Sitka makes no mention of scheduling the export of the volume. Therefore, one of ordinary skill in the art would understand that once the volume can be exported from the library, the exportation occurs as soon as possible. The Board previously concluded that a time hinging on as soon as possible is distinguishable from "second data identifying a second time at which the one or more removable media is scheduled to be exported," as recited in claim 1. (Board Decision⁸ at p. 7, lines 20-23.) Accordingly, Sitka's exporting a volume as soon as possible does not correspond to scheduling the export of removable media and exporting the removable media at the scheduled time.

Accordingly, the Examiner's finding that Sitka discloses scheduling the export of removable media and exporting the removable media according to the schedule is a clear error. Therefore, the Board should disregard the Examiner's finding.

D. The Examiner Again Fails to Clearly Articulate Why the Claims Would Have Been Obvious

To support a conclusion of obviousness of the claims, the Examiner must make certain findings and clearly articulate her reasoning with some rational underpinning. (See *KSR Int'l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (U.S. 2007), citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).)

⁸ Board Decision on Appeal, decided April 11, 2008, Appeal No. 2008-1254.

As noted above, the Examiner has made an incorrect finding as to what Sitka teaches. The Examiner also has not clearly articulated why claims 1-20 would have been obvious. In the Appeal Brief, the applicants noted how the Examiner repurposed old arguments, previously rejected by the Board, into a rationale for supporting her conclusion of obviousness. (See Appeal Brief at p. 17 and 18.) The Examiner has set forth essentially the same rationale, not once but twice, in the Answer. (Cf. Answer at pp. 5 and 12 with the Final Office Action at pp. 3-4.) In particular, the applicants direct the Board's attention to the Examiner's statement on page 12 of the Answer:

therefore, in light of the prior art, an ordinary skilled artisan at the time the inventions was made is deemed to be motivated to edit the common interface of Crouse with the import/export commands technique as taught by Sitka, such that the combined inventions of Crouse and Sitka are deemed to be prima facie obvious in view of the claimed limitations.

Deeming the *applied references* prima facie obvious in view of the claims is hardly a clear articulation of a reason why claims 1-20 would have been obvious. Moreover, because the Examiner states that the only motivation one of ordinary skill in the art would have to combine Crouse and Sitka would be to arrive at applicants' inventions, the Examiner's reasoning is circular and arguably based on impermissible hindsight.

In sum, the Examiner has not clearly articulated why claims 1-20 would have been obvious under 35 U.S.C. § 103(a). Therefore, the Board should disregard the Examiner's conclusion that these claims are obvious under 35 U.S.C. § 103(a) in view of Crouse and Sitka.

CONCLUSION

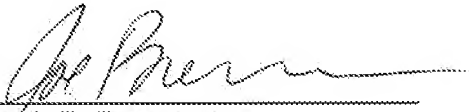
The Examiner takes a position inconsistent with her earlier rejection, misinterprets the claim language, makes an unsupported finding, and does not clearly articulate why the claims would have been obvious. Most importantly, the Examiner's Answer does not cure the deficiencies of the Final Office Action, both (i) in that the Examiner has failed to meet her burden of producing a *prima facie* case of unpatentability of claims 1-20, and (ii) in that each pending claim is nonobvious to a person of ordinary skill in the art under 35 U.S.C. § 103(a).

Accordingly, the applicants respectfully request that the Board reverse the Examiner's rejection of pending claims 1-20.

Please charge any deficiency in fees or credit any overpayment to our Deposit Account No. 50-0665, under Order No. 606928006US from which the undersigned is authorized to draw.

Dated: June 16, 2009

Respectfully submitted,

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